

Remarks

This Amendment is responsive to the Office Action mailed April 22, 2005 that provided a three-way restriction/election requirement amongst the pending claims. In response, the Applicant has herein amended claims 1 and 25 to more particularly point out and distinctly claim the subject matter of the present invention in view of the stated bases for the restriction/election requirement. The Applicant has furthermore provisionally elected the claims of group I with traverse. These amendments are proper, do not introduce new matter, are broadening and thus not narrowing in view of a prior art rejection, and places the application in proper condition for reconsideration and cancellation of the restriction of claims and allowance of all pending claims.

Restriction/Election Requirement

The Office Action of April 22, 2005 sets forth a three-way restriction/election requirement among the following groups: group I claims 1-9, and 21-24; group 2 claims 25-29; and group III claims 30-33.

The Applicant provisionally elects the group I claims 1-9 and 21-24 with traverse, on the basis that the restriction/election requirement has no basis in the law as discussed below.

Groups I and II

The method claims of group I were restricted from the apparatus claims of group II on the following basis: "In the instant case, the product of Group II can each be made by a materially different process, such as aligning the angular references axes of the disc with shear forces, as opposed to aligning by rotating the discs as required by Group I." (Office Action of 4/22/2005, para. 4)

There is no basis in the law for this restriction because rotating the discs as claimed requires a shear force to do so; that is, to rotate the angular reference of one disc in relation to an angular reference of another disc requires a rotary shear force. The Examiner's asserted basis for the restriction is misplaced as a distinction without a difference. Nevertheless, solely to facilitate prosecution on the merits, the Applicant has amended claim 1 to change the term "rotated" to the term "placed," and amended claim 25 to change the terms "rotatable" and "rotating" to "placeable" and "placing" (two places), respectively.

These amendments obviate the stated basis for the restriction between the claims of groups I and II. Withdrawal of this restriction is respectfully requested.

Groups I and III

The method claims of group I were restricted from the apparatus claims of group III on the following basis: "In the instant case, the process of Group I can be used to make a materially different product, such as one without any prewritten servo information on the motor." (Office Action of 4/22/2005, para. 5)

There is no basis in the law for this restriction because on its face it evidences that the Examiner misconstrued the claim. The Examiner's asserted materially different product, "such as one without any prewritten servo information on the motor" is wholly ambiguous. A skilled artisan, having read the present written description in light of the language of claim 30, could only reasonably conclude that the Examiner misconstrued the language of claim 30. Particularly, claim 30 reads in part: "a disc stack formed by steps for stacking two or more discs with prewritten servo information on the motor." Clearly, the phrase "with

"prewritten servo information" describes a feature of the discs, not the motor as the Examiner concluded.

The Applicant is grateful to Mr. Tugbang's willingness to discuss the basis for this restriction by telephone with Applicant's representative M. McCarthy on May 23, 2005. Mr. Tugbang explained that his stated basis for the restriction is to be interpreted as follows: "such as one without any prewritten servo information (with respect to the discs) on the motor." In other words, Mr. Tugbang explained that the language of claim 30 could reasonably be construed to cover a data storage device built with discs that do not already have servo information written to them.

The Examiner's construction of claim 30 is erroneous. First, the plain language of claim 30 recites "a disc stack formed by steps for stacking two or more discs with prewritten servo information...." The claim explicitly does not contemplate discs without prewritten servo information on them.

Second, as discussed previously by Applicant, claim 30 is a steps-for claim under Section 112 paragraph 6. The Applicant reiterates the following from the previously filed Amendment:

The Applicant has identified the function associated with the recited "means" element as being the placing and biasing of substantially identically prewritten discs, with respect to servo information orientation, in forming a desired disc stack. Accordingly, the disclosed structure performing this function in some embodiments includes the disc 108 and programmed instructions for performing methods in accordance with the embodiments of the present invention, which in some embodiments comprises the process steps illustrated in FIG. 3.

The Examiner is obliged as a matter of law to construe this means element as this structure, and equivalents thereof, that are capable of the identical function. See *Braun Medical, Inc. v. Abbott Lab.*, 43 USPQ2d 1896,

1900 (Fed. Cir. 1997); *In re Donaldson Co. Inc.*, 26 USPQ2d 1845 (Fed. Cir. 1994)(*en banc*); *In re Dossel*, 42 USPQ2d 1881 (Fed. Cir. 1997); *Supplemental Examination Guidelines for Determining the Applicability of 35 U.S.C. 112, Para. 6*, 65 FR 38510. Failure to do so constitutes reversible error.

(Amendment filed 1/31/2005, emphasis added)

The Examiner simply cannot ignore the stated function of stacking prewritten discs in construing claim 30 in accordance with Section 112 paragraph 6. The skilled artisan readily recognizes it would be futile to build a disc stack in accordance with the claimed "steps for stacking" with discs that have no servo information written to them. The entire purpose of the "steps for stacking" is to properly orient the angular reference of the discs in order to align the servo tracks of the discs. In-situ servo track writing, which the Examiner alleges to be an alternative product within this claim, aligns the servo tracks between discs by fixing them in the stack and then writing the servo information.

There is no basis in the law for this restriction because it is based on a misplaced construction of the language and scope of claim 30. Withdrawal of this restriction is respectfully requested.

Groups II and III

The apparatus claims of group II were restricted from the apparatus claims of group III as subcombination/combination on the following basis: "In the instant case, the invention of Group III has separate utility such as providing servo information on the motor." (Office Action of 4/22/2005, para. 6)

As above for the groups I and III restriction, there is no basis in the law for this restriction because on its face it evidences that the Examiner misconstrued the claim. The

Examiner's asserted separate utility, "such as providing servo information on the motor" is wholly ambiguous. A skilled artisan, having read the present written description in light of the language of claim 30, could only reasonably conclude that the Examiner misconstrued the language of claim 30. Particularly, claim 30 reads in part: "a disc stack formed by steps for stacking two or more discs with prewritten servo information on the motor." Clearly, the phrase "with prewritten servo information" describes a feature of the discs, not the motor as the Examiner concluded. There is absolutely no support in the specification, or within the knowledge of a skilled artisan, that would reasonably conclude that claim 30 reads on a device providing servo information "on the motor" instead of "on the discs."

The Examiner has based this restriction solely on facts within his personal knowledge. In accordance with 37 C.F.R. 1.104(d)(2) the Applicant respectfully requests that the Examiner provide an evidentiary affidavit, therefore subject to contradiction and explanation by Applicant's affidavit, supporting what is meant exactly by "providing servo information on the motor."

Otherwise, there is no basis in the law for this restriction because it is based on a misplaced construction of the language and scope of claim 30. Withdrawal of this restriction is respectfully requested.

Generic Linking Claim

Additionally, the restriction/election requirement is traversed on the basis that claim 30 is a generic linking claim, as properly construed under Section 112 paragraph 6, that covers both the method of claim 1 and the apparatus of claims 25 and 30. (MPEP 809.03)

Conclusion

This Response is a complete response to the restriction/election requirement mailed April 22, 2005. The Applicant respectfully requests that the Examiner enter the above amendments, reconsider the application, withdraw the restriction, and allow all of the pending claims. The Applicant has furthermore filed herewith a Request for Telephone Interview at a time before the Examiner makes any action on the merits other than passage of all claims to issuance. The interview is necessary to clarify disputed issues where the RCE and this restriction/election requirement have unduly delayed the issuance of Applicant's valuable patent rights. The Examiner is invited to contact the below signed Attorney should any questions arise concerning this response or the request for interview.

Respectfully submitted,

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